



U1P-1643

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit : 1643
Examiner : M. Davis
Serial No. : 09/503,089
Filed : February 11, 2000
Inventors : Amanda J. Patel
: Eric Honore
: Florian LeSage
: Georges Romey
: Michel Lazdunski
Title : A METHOD FOR THE
: IDENTIFICATION OF
: ANESTHETICS

Customer No. 22469

Docket No.: 1201-CIP-3-00

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Dated: July 9, 2001

Commissioner for Patents
Washington, DC 20231

Sir:

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Response
Copy of MPEP 803

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Name of Applicant, Assignee, Applicant's Attorney
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Date: _____ 9 July 2001



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RESPONSE

Commissioner for Patents
Washington, DC 20231

Sir:

This is submitted in response to the Official Action dated May 9, 2001. We acknowledge the restriction of the Application into 14 different groups and respectfully traverse such restriction.

Although we traverse the restriction for the reasons set forth in detail below, we hereby elect Group V including Claims 13 - 14 for immediate prosecution on the merits.

We respectfully submit that this Application should be divided into no more than three groups. We propose the three groups as follows:

Group I including Claims 1 - 2 and 7 - 8

Group II including Claims 3 - 6 and 9 - 12

Group III including Claims 13 - 25

The new groupings are suggested for the following fundamental, underlying reason:

Group I may be found in Class 536, Sub-class 23.5; Group II may be found in Class 530, Sub-class 350; and Group III may be found in Class 435, Sub-class 7.2.

In accordance with MPEP 803, convenience copy enclosed, we note that the two criteria for a proper requirement for restriction between patentably distinct inventions is:

(A) The inventions must be independent or distinct as claimed

and

(B) There must be a serious burden on the examiner if restriction is required.

We respectfully submit that the restriction requirement as proposed in the Official Action does not meet this test inasmuch as there would be no serious burden on the Examiner to restrict the case into only three different groups. This is true because it would be quite simple to search for relevant prior art for inventions in, for example, Class 536, Sub-class 23.5. This covers Group I and Group III of the groups originally proposed in the Official Action. We respectfully submit that inventions classified in exactly the same class and exactly the same sub-class would not present any burden at all, much less a serious burden for searching purposes as required in the MPEP.

Thus, we have proposed a new Group I which is based on Groups I and III from the Official Action. Similarly, we respectfully submit that there would be no serious burden for searching inventions that may be found in Class 530, Sub-class 350. Accordingly, we propose combining Groups II and IV from the Official Action into a new Group II, which may be found in Class 530, Sub-class 350. Finally, we propose combining Groups V - XIV into a single Group III based on the fact that the Official Action admits that all of those inventions may be found in Class 435, Sub-class 7.2. Again, we respectfully submit that there would be virtually no burden to search inventions admittedly falling within the same class and sub-class.

By way of summary, although the inventions may be independent or distinct as claimed, there would be no serious burden to restrict the case into only three groups as proposed above by the Applicants, as opposed to the 14-way restriction proposed in the

Official Action.

In light of the foregoing, we respectfully request that the 14-way restriction be withdrawn in favor of a three-way restriction as proposed by the Applicants above based on the admission in the Official Action that there are but three classes and sub-classes to be searched among the three groups and that there would be no serious burden to conduct such a search based on three groups.

Respectfully submitted,


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"Independent", of course, means not dependent. If "distinct" means the same thing, then its use in the statute and in the rule is redundant. If "distinct" means something different, then the question arises as to what the difference in meaning between these two words may be. The hearings before the committees of Congress considering the codification of the patent laws indicate that 35 U.S.C. 121: "enacts as law existing practice with respect to division, at the same time introducing a number of changes."

The report on the hearings does not mention as a change that is introduced, the subjects between which the Commissioner may properly require division.

The term "independent" as already pointed out, means not dependent. A large number of subjects between which, prior to the 1952 Act, division had been proper, are dependent subjects, such as, for example, combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc. If section 121 of the 1952 Act were intended to direct the Commissioner never to approve division between dependent inventions, the word "independent" would clearly have been used alone. If the Commissioner has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., the examples used for purpose of illustration above. Such was clearly not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term "distinct" with the term "independent", indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above may be properly divided if they are, in fact, "distinct" inventions, even though dependent.

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

It is further noted that the terms "independent" and "distinct" are used in decisions with varying meanings. All decisions should be read carefully to determine the meaning intended.

802.02 ■■■■■ Definition of Restriction

Restriction, a generic term, includes that practice of requiring an election between distinct inventions, for example, election between combination and subcombination inventions, and the practice relating to an election between independent inventions, for example, and election of species.

803 ■■■■■ Restriction — When Proper

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 – § 806.04(i)) or distinct (MPEP § 806.05 – § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

CRITERIA FOR RESTRICTION BETWEEN PATENT-ABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 – § 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) – § 806.04(i), § 808.01(a), and § 808.02).